

shape of the sugar wafer and which is sufficiently solid to retain the second desired shape under ambient temperature.

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### REMARKS

Claims 1 and 3-23, as amended, are pending for the Examiner's review and consideration. Claims 1, 10, 21, and 23 have been amended to remove the terms "semi-liquid" and "semi-solid" since these terms are alleged to be indefinite yet are encompassed by the term "molten." Claims 3 and 11 have been amended to clarify that the molten confectionery filling is semi-solid or semi-liquid and flows to conform to the cone shape (*See, e.g.*, Specification at page 3, lines 9-33; page 5, lines 11-15; and Examples 1-3). Claim 5 has simply been amended to clarify that it is a combination that includes two particular components, chocolate and vegetable fat (*See, e.g.*, Specification at page 3, lines 27-30), however, no modification in scope is intended. Claim 23 has also been amended to recite the term providing, which is broader than a specific process step such as "molding." No new matter has been introduced by any of the amendments herein, such that entry of the claims is warranted at this time. The marked up amended claims are attached hereto as Exhibit A, and a set of pending claims is attached hereto as Exhibit B.

Claims 22-23 are rejected under 35 U.S.C. § 112, first paragraph, for the reason on page 2 of the Office Action. The Office Action states that the feature of claim 22 is not found in the specification and the process of "molding the food product" and "portion of the mass flows to conform" and "filling in a second desired shape that corresponds to the desired shape of the sugar wafer and which is sufficiently solid to retain the second desired shape" are not identically found in the specification. Initially, Applicants apologize for the use of the narrower word "molding," which does not exist in the specification. Applicants have amended claim 23 to recite the non-limiting term providing to obviate the first part of this rejection.

As to the other two aspects of claim 23 that are rejected, the Office Action is correct that this identical language is not explicitly present. That strict requirement, however, is not the test for whether claim language is sufficiently enabled.

Indeed, before even reaching the alleged merits of this rejection, Applicants note that the burden is on the Patent Office to demonstrate lack of possession of the invention

in the claim terms. MPEP § 2163.04.<sup>1</sup> The Patent Office has failed to do so here. It is patently clear that a portion of the mass flows to conform to the sugar wafer when provided into the wafer, since the mass is added in molten (including semi-solid or semi-liquid) form. These states of matter all involve a flowable material, as is well understood by those of ordinary skill in the art, that then hardens or solidifies in place after it fills the sugar wafer. Hardened materials then retain their shape, as is also well understood by those of ordinary skill in the art.

The Office Action appears to overlook several other aspects in its improper lack of possession of the invention-type rejection. As is well known, mere rephrasing of a passage in a claim does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973); *see* MPEP § 2163.07. Applicants have simply reworded features specifically disclosed in the specification in an expected and well-understood manner to those of ordinary skill in the art. No new meaning is intended by rewording the features of the application and making them into perfectly acceptable claim amendments.

Indeed, by disclosing in a patent application a material inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be properly amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973); *see* MPEP § 2163.07(a). Moreover, there is no inconsistency between the amended claim language and the specification, such that this cannot be the basis of a proper rejection. MPEP § 2173.03.

Based on the proper interpretation of the judicial decisions and the MPEP, it is clear that the claims are sufficiently supported by the specification that no lack of possession of the invention rejection is proper here. It is clear that the term "molten" refers to a

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<sup>1</sup> A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *See, e.g., In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97.

solid that has been reduced to a liquid state, such as by heat. If the material is partly reduced to a liquid state, it must then be a semi-solid or semi-liquid that contains some of each phase. If the material is completely reduced to a liquid state, it is a liquid. These are basic concepts well understood by those in the art of materials science and, moreover, this is a conventional definition of the term "molten." For example, a molten state can be one where the fat is completely melted or from a state where the fat is partially crystallized (acting as seed for crystal growth at 0.5-25% of the fat solid), where the fat is then sufficiently solidified.

Based on this well understood term "molten," it should be clear that a molten, or heated material at least partly reduced to the liquid state, is flowable (Specification at page 5, lines 10-15). Flowability is a defining characteristic of conventional materials in the liquid state. When a flowable material is placed into a container, such as a shaped sugar wafer, some of the flowable material (*i.e.*, the molten confectionery mass) will inevitably conform to the shape of the sugar wafer. Thus, the claim recitation that a "portion of the mass flows to conform to the shape of the sugar wafer" is inherently or explicitly supported as well as being supported in the spirit of the specification. This is readily understood by those of ordinary skill in the art. As previously discussed, the burden is on the Patent Office to demonstrate lack of possession of the invention in the claim terms. MPEP § 2163.04.

The other language of concern to the Patent Office is the "filling in a second desired shape that corresponds to the desired shape of the sugar wafer and which is sufficiently solid to retain the second desired shape." As previously discussed, the wafers are shaped (*See, e.g.*, Specification at page 3, line 7) and any molten material placed therein will inevitably flow to conform to that shape. The fact that the molten confectionery mass is then permitted to harden in situ is explicitly disclosed (*See, e.g., Specification* on page 5, lines 11-15). The fact that the "dome shape" disclosed in each of the three (3) examples is clear explicit support in the specification that the confectionery material of the invention is "sufficiently solid to retain the second desired shape." Again, the burden is on the Patent Office to demonstrate lack of possession of the invention in the claim terms, particularly since the specification has at least clear inherent and/or inevitable disclosure of the features recited in claim 23. MPEP § 2163.04.

Claim 22 was rejected because the exact language "solid under ambient temperature" is not present in the specification. Again, that is not the test. Nonetheless, support for this claim language exists in the language "filling the sugar wafer with . . . molten, semi-liquid or semi-solid mass, and allowing the filling to harden." (*Specification* on page 5, lines 11-15). Clearly, even a liquid or a gas that "harden" must have undergone a

change of state to a solid in order to "harden." There are no other conventional states of matter--just solid, liquid, and gas; and only solids are formed when a substance hardens, particularly in the culinary art. No special temperature is recited in connection with this hardening of the filling, and thus, the conventional understanding--particularly to those of ordinary skill in the art--is that this hardening occurs under ambient temperature and other ambient conditions. Applicants have therefore recited that the mass is solid under ambient temperature, and respectfully submit that it is well supported by the specification.<sup>2</sup>

Moreover, the specification contains three (3) examples, each of which also indicate the filling hardens after the sugar wafer is filled therewith. Further, the specific materials in these three Examples, as well as the filling materials on page 3, lines 8-33 of the Specification, disclose materials that are inherently solid rather than liquid or gas at ambient temperature, as will be well understood by those of ordinary skill in the art. It should also be understood that a liquid fat can be combined with other material(s), as discussed in the Specification, to provide a solid confectionery material as presently recited.

The Examiner should still consider the subject matter added to claim 23 in making a rejection based on prior art, since the new matter rejection may be overcome by Applicant. MPEP § 2163.06. Here, the Office Action does not give proper weight to the terms of claim 23. Applicants respectfully request that the features of claims 22-23 be fully considered, as they help render claim 22-23 separately patentable from the other independent claims. For these reasons, the rejection under 35 U.S.C. § 112, first paragraph, has been obviated and should be reconsidered and withdrawn.

Claims 1 and 3-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in using the terms "semi-liquid" and "semi-solid" because they are not defined by the specification. There is no requirement that each and every term in a patent claim be "defined," as the Office Action seems to mandate. This is improper, and 35 U.S.C. § 112, second paragraph, requires only that the claim particularly point out and distinctly claim the subject matter of the invention. In view of the previous discussion regarding "molten," Applicants have amended the claims to refer only to the term molten in the independent claims in a continued effort to expedite prosecution. The term "molten" broadly

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<sup>2</sup> If the Patent Office prefers that the Applicants use the term "hard under ambient temperature," which is more explicitly supported in the specification, the Examiner is expressly authorized to make such an amendment. The term "hard," however, seems to be somewhat indefinite and Applicants believe that "solid" better complies with statutory requirements.

encompasses the terms "semi-liquid" and "semi-solid" and therefore no modification in claim scope has occurred by this amendment. Rather, the independent claims have been simply clarified without modification of scope in this regard. Claims 3 and 11, however, have been amended to include these terms along with clarifying language that the "semi-solid" or "semi-liquid" confectionery material must be flowable to conform to the cone shape. Naturally, a chunk of ice with drops of water on it is not a "semi-liquid" or "semi-solid" as more clearly recited, since it would not flow to conform to the shape of an object (in addition to not being substantially water-free, as also recited). The terms "semi-solid" and "semi-liquid" are not indefinite because those of ordinary skill in the art will readily understand the scope and meaning of these terms, particularly with reference to the specification and as now recited in claims 3 and 11 with the further clarifying language regarding materials that flow to conform to the shape of an object in which they are placed. Claim 23 already recites this additional language regarding the ability of the molten materials to flow and conform. Thus, these rejections under 35 U.S.C. § 112, first and second paragraphs, are respectfully submitted to be improper and have been obviated by these amendments and remarks, and the rejections should be withdrawn.

Claims 1 and 3-21 were rejected under 35 U.S.C. § 103 (a) as being obvious over WO 00/13512 to Conti et al. ("Conti") on pages 3-4 of the Office Action. Applicants respectfully traverse. The Office Action states that Conti teaches sugar wafers with confectionery materials such as chocolates or other fatty material such as fat-based cream, and that a moisture barrier of chocolate or a substitute may be used between the sugar wafer and other confectionery material. It is also stated that the confectionery material preferably has a low water activity such as a fat-based cream including yogurt. The Office Action concedes that Conti does not disclose the product size, hardening, or the inclusion of edible inclusions.

Conti clearly does not disclose or suggest several recited features. Indeed, it specifically teaches away from several recited features<sup>+</sup>. For example, yogurt is well known to contain water content, even with a 0.3 water activity, while the claims recite a substantially water-free material. Indeed, Conti even acknowledges the problem of using conventional water-based confectionery fillings by stating that it is preferably to minimize moisture migration problems. But Conti teaches the possible use of a moisture barrier between the sugar wafer and its confectionery fillings to solve this problem, while the present invention recites a different solution--substantially water-free confectionery materials, which avoid the problems in the first instance that can occur using water-containing materials.

The claims recite that the mass has solidified or hardened in the sugar wafer, while Conti clearly discloses yogurt or fat-based creams, which are not understood by those of ordinary skill in the art to solidify or harden after they are placed in a sugar wafer. Rather, it would be expected that Conti's materials would remain fluid/flowable. Thus, Conti fails to teach that its different (*i.e.*, not substantially water-free) confectionery mass has solidified in the sugar wafer. The solidifying aspect of the claimed invention is a surprising and unexpected benefit that elegantly facilitates processing and then can avoid melting in hot weather or during prolonged handling as is typical with ice cream products (*See* Specification, page 2, lines 17-18).

The Patent Office alleges the filling materials of Conti could be allowed to harden if such a taste and/or texture were desired, however, this is no more than a hindsight rejection. The different materials are not used herein to simply obtain a different taste and/or texture. Indeed, they are used to obtain a food product that has the advantages of frozen ice confectioneries without the disadvantages. For example, the present invention can look and feel like an ice cream cone, and can have a filling that is sinfully delicious, but has the enormous benefit that it will not melt like a frozen ice confection. This is an enormous advantage, and one having long-felt need in the art. Also, one of ordinary skill in the art would not have been motivated to use a completely different confectionery material as a filling based on the teachings of Conti. Moreover, the selection of completely different materials having different properties to solve a problem in a different way cannot be obvious --it is the *essence* of patentability.

Thus, Conti fails to disclose or even suggest: (1) substantially water-free materials; and (2) materials that solidify or harden. In fact, Conti has explicit teachings away from each of these recited features. As such, no *prima facie* case of obviousness exists in the cited reference, and none has been stated on the record.

Moreover, several claims have other or additional separately patentable features. For example, as to claim 23, the yogurt of Conti would not retain the desired shape in the wafer at ambient temperature since it is still flowable, *i.e.*, it has not hardened. Thus, Conti does not teach the importance of a material that flows to conform but then solidifies to retain the second desired shape under ambient temperature, as presently recited. Claims 5-6 and 14 also clearly have not been addressed by the Office Action as required by 37 C.F.R. § 1.104(b). Claim 5 was amended to clarify that it recites a combination that includes both chocolate and vegetable fat in particular amounts. These claims recite confectionery filling materials that are simply not disclosed or suggested by Conti, which *teaches away* from

substantially water-free materials, and should be allowable if rewritten in independent form. Also, the dome shape of claims 17 and 20 is not disclosed or even suggested--and in any event simply *cannot* be obtained using a yogurt or cream-based material that does not solidify, since these are flowable materials that cannot be shaped into a dome. This is another of the surprising and unexpected benefits of the present invention, which provides a food product having the appearance of an ice cream cone or other frozen confection without the disadvantage of rapid melting in hot weather or in a consumer's hands.

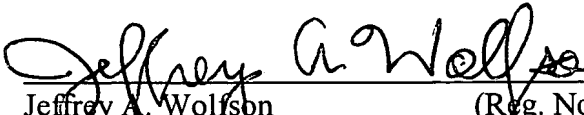
As a reminder, Applicants would like to make clear for the record that claims 1, 3-9, 18-20, and 22 recite a food product and claims 10-17, 21, and 23 recite a process for preparing a food product. Even the Examiner acknowledged the difference between the two types of claims during the Interview of April 24, 2002, when it was indicated that the amendment clarifying the process claims would probably distinguish over the prior art pending further search. With all due respect, the new rejection also overlooks this distinction and the method claims should also be patentable for this reason. For these reasons, the rejection of claims 1 and 3-21 under 35 U.S.C. § 103(a) should be reconsidered and withdrawn, since no *prima facie* case of obviousness has been stated on the record.

Accordingly, the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No fee is believed to be due for this submission. Should any fee be due, however, please charge the required fee to Winston & Strawn Deposit Account No. 501-814.

Respectfully submitted,

1/16/03  
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Date

  
Jeffrey A. Wolfson (Reg. No. 42,234)  
For: Allan A. Fanucci (Reg. No. 30,256)

**WINSTON & STRAWN**  
**Customer No. 28765**

(202) 371-5770

## **APPENDIX A: MARKED-UP AMENDED CLAIMS**

1. (Twice Amended) A food product comprising a sugar wafer cone having a filling including a mass of a substantially water-free based confectionery material that has solidified in the sugar wafer cone from a molten [, semi-liquid, or semi-solid] mass prior to consumption, so that the cone acts as a handle to keep a user's hands clean during eating of the product and the product combines the pleasure and fun of eating an ice cream cone with the indulgence of a fat-based confection.

3. (Three Times Amended) A food product according to claim 1, wherein the food product has a weight of 5 to 40 g and is bite-sized or a 2-3 bite sized piece, and wherein the sugar wafer solidifies from a semi-liquid or semi-solid mass that is sufficiently flowable to conform to the cone.

5. (Amended) A food product according to claim 1, wherein the filling comprises from about 40 to 10% of a vegetable fat in combination with dark chocolate, milk chocolate or white chocolate, or any mixture thereof or products derived from sugar with or without milk derived components, or fat and solids from vegetable or cocoa sources, chocolate substitutes containing direct cocoa butter replacements, or stearines, or coconut oil, or palm oil, or butter or any mixture thereof; or nut pastes, or praline or confectioner's coatings comprising chocolate analogues with cocoa butter replaced by a non-tempering vegetable fat containing from about 60 to 90% chocolate [and from about 40 to 10% of a vegetable fat].

10. (Three Times Amended) A process for preparing a food product comprising a sugar wafer having a substantially water-free fat based confectionery filling which comprises providing the sugar wafer in a desired shape, introducing a substantially water-free fat-based confectionery in a molten [, semi-liquid or semi-solid] mass upon or into the shaped sugar wafer, and allowing the confectionery mass to harden to form the food product.

11. (Amended) A process according to claim 10, wherein the sugar wafer is provided in the shape of the cone and the molten confectionery filling is introduced to at least partially fill the cone, with the cone acting as a handle to keep a user's hands clean



during eating of the product and the product combining the pleasure and fun of eating an ice cream cone with the indulgence of a fat-based confection, wherein the molten confectionery filling includes a semi-solid or semi-liquid portion that is flowable to fill and conform to a part of the cone.

21. (Twice Amended) The process of claim 10, wherein the introducing comprises disposing molten [, semi-liquid, or semi-solid] mass into the shaped sugar wafer.

23. (Amended) A process for providing [molding] a food product which comprises:

forming a sugar wafer in a desired shape;

providing a substantially water-free fat-based confectionery in a molten [, semi-liquid or semi-solid] mass upon or into the shaped sugar wafer so that a portion of the mass flows to conform to the shape of the sugar wafer; and

solidifying the confectionery mass sufficiently to form a substantially water-free fat-based confectionery filling in a second desired shape that corresponds to the desired shape of the sugar wafer and which is sufficiently solid to retain the second desired shape under ambient temperature.